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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,184	02/07/2002	Steve R. Dobler	42390P13681	3500

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EXAMINER

WOO, ISAAC M

ART UNIT	PAPER NUMBER
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2172

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DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/072,184

Applicant(s)

DOBLER, STEVE R.

Examiner

Isaac M Woo

Art Unit

2172

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 12 recite the limitation "A method" in claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 20 recites the limitation "A article" in claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 28 recites the limitation "A apparatus" in claim. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-30 are rejected under 35 U.S.C. 101 because the claim invention is directed to non-statutory subject matter.

**MPEP 2106 IV. B.2. (b)**

A claim that requires one or more acts to be performed defined a process. However, not all processes are statutory under 35 U.S.C. 101. Schrader, 22 F. 3d at 296, 30 USPQd at 1460. To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts.

**MPEP 2106. II.A**

Process that consists solely of the maculation of an abstract idea not concrete or tangible. See In re Warmerdam, 33 F3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994).

Claims 1, 12, 20 and 28, in view of the above cited MPEP sections, are not statutory because they merely recite a number of computing steps without producing any tangible result and/or being limited to practical application within the technological arts. The use of a computer has not been indicated.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wako (U.S. Patent No. 6,687,605).

With respect to claims 1, 12, 20 and 28, Wako discloses, receiving one or more partial telephone number having one or more digits corresponding to a candidate communication number from a digit inputter, see (102, fig. 4, col. 1, lines 52-67 to col. 2, lines 1-67, col. 4, lines 24-35, by inputting leading few digits, col. 7, lines 1-12); searching a database for a telephone number corresponding to the one or more digits of the candidate communication number, see (col. 1, lines 52-67 to col. 2, lines 1-67, col. 4, lines 24-35, col. 7, lines 1-12); locating within the database a telephone number corresponding to the one or more digits of the candidate communication number, see (col. 1, lines 52-67 to col. 2, lines 1-67, col. 4, lines 24-35, col. 7, lines 1-12); and transmitting a located communication number to a presenting location, see (fig. 5b, IPT, col. 4, lines 16-34). Wako discloses, presenting telephone number, see (fig. 5b, IPT, col. 4, lines 16-34) Wako does not explicitly discloses, presenting telephone number prior to receiving an entire candidate communication number. However, Wako discloses, "when the user inputs, using the key pad, the leading few digits of the telephone number of the facilities as the destination, the navigation system retrieves the telephone number database and displays a list of the telephone numbers having the same leading few digits under the key pad", see (col. 4, lines 28-34). Wako also discloses, "Next, if the user operates the zoom/scroll key 16e and selects the telephone number of a desired

facility from the list, the telephone number will be highlighted on the list (step 104)", see (col. 4, lines 35-38). This teaches that the telephone numbers presented only by inputting few digit of numbers (without typing whole digit of telephone number), which means the telephone numbers are displayed prior to receiving an entire candidate communication number (telephone number). Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to include presenting telephone number prior to receiving an entire candidate communication number in the system of the Wako. Because displaying candidate list of numbers by inputting only partial digit provides saving user's typing time.

With respect to claims 2 and 29, Wako discloses, the communication number comprises a telephone number, see (col. 4, lines 24-35).

With respect to claims 3-4 and 17-18, Wako discloses, the database contains one or more telephone numbers previously dialed or incoming calls from a telephone, see (col. 4, lines 40-54).

With respect to claims 5-6, 15-16 and 30, Wako discloses, the database is located in a telephony system, see (col. 4, lines 24-35).

With respect to claims 7-9, Wako discloses, the presenting location comprises a data display location of the electronic network system, see (col. 2, lines 35-67, col. 3, lines 49-67 to col. 4, lines 1-11).

With respect to claim 10, Wako discloses, searching the database for the communication number corresponding to the one or more digits of the candidate communication number comprises searching the database after receiving each digit following a group of the one or more digits of the candidate communication number, see (col. 1, lines 52-67 to col. 2, lines 1-67, col. 4, lines 24-35, col. 7, lines 1-12).

With respect to claim 11, Wako discloses, transmitting one or more located communication numbers corresponding to the one or more digits of the candidate communication number from the database to the presenting location prior to receiving the entire candidate communication number; and reducing the one or more located communication numbers, as the one or more located communication numbers fail to contain each subsequently received digit of the candidate communication number, see (col. 1, lines 52-67 to col. 2, lines 1-67, col. 4, lines 24-35, col. 7, lines 1-12).

With respect to claims 13-14, Wako discloses, the digit inputter comprises a telephone keypad and voice activating dialing mechanism, see (col. 3, lines 48-67 to col. 4, lines 1-11, col. 4, lines 24-35, col. 7, lines 1-12).

With respect to claim 19, Wako discloses, receiving a selection indication to select a located telephone number appearing on the display screen of the telephone; and dialing, as a result of receiving the selection indication, a selected located telephone number appearing on the display screen of the telephone, see (col. 3, lines 48-67 to col. 4, lines 1-11, col. 4, lines 24-35, col. 7, lines 1-12).

With respect to claim 21, Wako discloses, the electronic system to receive one or more digits of the candidate communication number comprise sequences of instructions that, when executed, cause the electronic system to receive the one or more digits of a candidate telephone number, see (col. 3, lines 48-67 to col. 4, lines 1-11, col. 4, lines 24-35, col. 7, lines 1-12).

With respect to claim 22, Wako discloses, the electronic system to search a database containing one or more telephone numbers previously dialed from a telephone for the communication number corresponding to the one or more digits of the candidate communication number, see (col. 3, lines 48-67 to col. 4, lines 1-11, col. 4, lines 24-35, col. 7, lines 1-12).

With respect to claim 23, Wako discloses, the electronic system to search a database containing one or more telephone numbers of one or more devices previously attempting to establish a connection with a telephone for the communication number



corresponding to the one or more digits of the candidate communication number, see (col. 3, lines 48-67 to col. 4, lines 1-11, col. 4, lines 24-35, col. 7, lines 1-12).

With respect to claim 24, Wako discloses, the electronic system to search a database located in a telephony system for the communication number corresponding to the one or more digits of the candidate instructions that, when executed, cause the electronic system to search the database for communication number, see (col. 3, lines 48-67 to col. 4, lines 1-11, col. 4, lines 24-35, col. 7, lines 1-12).

With respect to claim 25, Wako discloses, the electronic system to search a database located in a telephony system for the communication number corresponding to the one or more digits of the candidate instructions that, when executed, cause the electronic system to search the database for communication number, see (col. 3, lines 48-67 to col. 4, lines 1-11, col. 4, lines 24-35, col. 7, lines 1-12).

With respect to claim 26, Wako discloses, the electronic system to transmit the located communication number to a telephone prior to receiving the entire candidate communication number, see (col. 3, lines 48-67 to col. 4, lines 1-11, col. 4, lines 24-35, col. 7, lines 1-12).

With respect to claim 27, Wako discloses, transmit one or more located communication numbers corresponding to the one or more digits of the candidate

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communication number from the database to the presenting location prior to receiving the entire candidate communication number; and reduce the one or more located communication numbers, as the one or more located communication numbers fail to contain each subsequently received digit of the candidate communication number, see (col. 3, lines 48-67 to col. 4, lines 1-11, col. 4, lines 24-35, col. 7, lines 1-12).

***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kobayashi (U.S. Patent No. 5,371,779) discloses the system for telephone call initiating system according to the invention is provided in order to make it possible to control telephone call initiation from an extremely small mobile communication terminal. This is accomplished with a key input section, a speech recognition section, a data base and display section, and a data base input control section for forming a record. The record consists of telephone number data from the key input section and data including family and given names from the speech recognition section. The record is stored into the data base. A search parameter accepting section searches the data base for the record according to data including the family and given names, and stores the retrieved record into a work area. A scroll control section scrolls, in predetermined units, the retrieved record and displays the data on the display section. A call initiation accepting section supplies a call initiating instruction according to the telephone number in the scrolled record, and a call initiation processing section responds to the call initiating instruction to initiate a call according to the telephone number.


**Contact Information**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac M Woo whose telephone number is (703) 305-0081. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E Breene can be reached on (703) 305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IMW  
February 12, 2004

  
SHAHID ALAM  
PRIMARY EXAMINER